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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,515	09/30/2003	Jacqueline Evynne Breuninger Buskop	1207.01A	6098
29637	7590	11/29/2005	EXAMINER	
BUSKOP LAW GROUP, P.C. 1776 YORKTOWN SUITE 550 HOUSTON, TX 77056			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/675,515

Applicant(s)

BUSKOP, JACQUELINE EVYNNE  
BREUNINGER

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to Applicant's amendment filed 8/25/2005.

#### ***Status of Claims***

- [1] Claims 1-2, 4-10, 12-14 are pending.

#### ***Drawings***

- [2] The drawing(s) were previously objected for informalities. In view of Applicant's replacement drawing(s) submitted on 9/13/2005, all previous objection(s) to the drawings have been withdrawn. Accordingly, the changes have been entered.

#### ***Specification***

- [3] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 8/25/2005. Accordingly, the objection(s) to the specification and abstract have been withdrawn.

#### ***Claim Rejections - 35 USC § 103***

- [4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [5] Claims 1-2, 4-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westmoland US-5,201,578, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such

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that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

- a. at least one earring clip (10 in view of col. 2, line 10, "For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears," as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;
- b. at least one hook (10b; from col. 7, beginning with line 4, "Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...") secured to said earring clip (10);
- c. at least one edible food item removably secured to said hook (10b; col. 7 beginning with line 4, "Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...", further, "Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached"), wherein said edible food item is selected from the group: a fruit, a vegetable, and combinations thereof. (Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).
- d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item (4; from col. 3, beginning with line 16, "Lighting elements 4 may be

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incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”).

Re: Claim 2, wherein at least one hook (10b) comprises at least two hooks (1<sup>st</sup>, 2<sup>nd</sup>, and 3<sup>rd</sup> 10b of Fig. 8) connected in series.

Re: Claim 4, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically, “The microchip may be designed to provide a controlled pattern of flashing to the lighting elements...” and further, “To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, “apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5.” Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 5, wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert.

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*denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 6, wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first and second prong) [for engaging at least two food items] (Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

Re: Claim 7, wherein the edible food item is selected from the group: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruitsfruits with similar sturdy yet pierce-able skins, and vegetables with similar sturdy yet pierce-able skins (col. 7 beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains,” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached” Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

As for Claim 8, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

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a. at least one earring clip (10 in view of col. 2, line 10, “For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears,” as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;

b. at least one hook (10b; from col. 7, beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...”)  
secured to said earring clip (10);

c. at least one chewy candy item removably secured to said hook (col. 7 beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains,” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached” Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”).

Re: Claim 9, wherein said candy is selected from the group: soft licorice, soft raspberries, juicy fruits, and like soft candies (note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably

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distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

Re: Claim 10, further comprising a line (5) wherein said hook (10b) connects said line (5) near said earring clip (10) and a second hook (1<sup>st</sup> segment of 29) connects to said line (5) further from said earring clip (10) than said hook (10b).

Re: Claim 12, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically, “The microchip may be designed to provide a controlled pattern of flashing to the lighting elements...” and further, “To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, “apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5.” Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 13, wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ



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at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 14, wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first and second prong) [for engaging at least two food items] (Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

### ***Response to Arguments***

[6] Applicant's amendment, see amendment and remarks filed 8/25/2005, with respect to the rejection(s) of claim(s) 1-14 under Dichtel, US-5,146,768, have been fully considered. Therefore, the rejection with regard to Dichtel has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Westmoland US-5,201,578. Also note an additional notice of reference cited has also been provided citing further relevant art in the instant case.

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*Conclusion*

**[7] THIS ACTION IS NON-FINAL**

**[8]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
**ROBERT J. SANDY**  
**PRIMARY EXAMINER**